significant than they once were. In the late 1990's, when the courts and Congress first began to worry about abusive domain name registrations and hence about how trademark law would apply to them, "guessing" a company's domain name, then typing that guess into a browser followed by ".com," was the main way for consumers to find the company online. The doctrine of initial interest confusion blossomed in that environment.[4] Since then, a variety of factors, including the widespread advertising of domain names, the proliferation of domains other than ".com," the development of powerful search engines, the increasing sophistication of Internet users, and the enactment of the ACPA as a weapon against predatory domain name registrations for the purpose of extortion, has reduced the degree of "name-guessing," the importance of domain name battles, and the need to invoke traditional Lanham Act theories to resolve domain name issues. The Court should wait for a case in which initial interest confusion has substantial social and technological significance before deciding whether, and to what extent, the doctrine should be made a permanent part of trademark law.

b. The Petition also portrays the ruling below as at odds with decisions of the Second and Ninth Circuits with respect to the question of whether the Lanham Act cause of action for

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[4] *See, e.g.*, Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 Cardozo L. Rev. 105, 109-110 (2005); Glazer & Dhamija, *Revisiting Initial Interest Confusion on the Internet*, 95 Trademark Reporter 952 (2005); Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 Emory L.J. 507, 559-565 (2005); Maynard, *The Initial Interest Confusion Doctrine and Trademark Infringement on the Internet,* 57 Wash. & Lee L. Rev. 1303 (2000).

infringement can apply to non-commercial uses of a mark. Pet. 15-24. This point does not merit review for two reasons. First, although Lamparello argued below that the Lanham Act applies only to commercial uses of trademarks, the Fourth Circuit expressly refused to address the issue: "In the case at hand, we need not address that question or decide whether Sections 32 and 43(a) apply exclusively to commercial speech . . .." Pet. App. 9a. The question thus is not properly presented here.

Second, although Falwell cites a Second Circuit case as supposedly standing in opposition to the Fourth Circuit on this point, Pet. 22-23, the case Falwell cites did not involve initial interest confusion, which is the only context in which the Fourth Circuit relied on the distinction between commercial competitors and non-commercial speech. And as noted above, all of the initial interest confusion cases cited in the Petition involved commercial competitors and commercial uses. Again, there is no division in lower court authority.

c. Finally, the second Question Presented seeks the Court's review of the question whether use of an Internet gripe site's domain name that is similar to a trademark can ever be a "bona fide" non-commercial or fair use and hence qualify under ACPA Factor IV. The ACPA cause of action incorporates two separate elements: that the domain name is identical or confusingly similar to or dilutive of plaintiff's mark, 15 U.S.C. § 1145(d)(1)(A)(ii), and that the name was registered or used with a "bad faith intent to profit." 15 U.S.C. § 1145(d)(1)(A)(i). The statute identifies nine factors that courts may consider in determining whether the "bad faith intent to profit" standard has been met. 15 U.S.C. § 1145(d)(1)(B)(ii)(I) to (IX). Although this aspect of the petition is not entirely clear, Falwell seems to argue that if a domain name is too similar to a trademark, it cannot meet the standard set forth by

one of the nine factors, Factor IV, "the person's bona fide non-commercial or fair use of the mark in a site accessible under the domain name."

This aspect of the petition does not warrant review for several reasons. To begin with, it was never argued to the court of appeals. In his appellate brief, Falwell made no mention of the ACPA in explaining why the district court's judgment should be affirmed. Although Falwell did raise an issue with respect to the ACPA in his petition for rehearing, his argument (at page 18 of the petition) **assumed** that Lamparello prevailed on Factor IV, but argued that Falwell should have prevailed on other factors. Thus, the issue of how to construe and apply Factor IV was not preserved for review. Moreover, Falwell does not point to any disagreement among the lower courts about how Factor IV should be construed. And, in any event, the Fourth Circuit's decision did not rest on its analysis of Factor IV – the court analyzed several other factors in deciding that bad faith intent to profit had not been shown. Pet. App. 23a (discussing Factors V, VI and VIII). Thus, the discussion of Factor IV was not outcome-determinative.

Most important, however, the Fourth Circuit's decision on the ACPA issue was not primarily based on an analysis of the discrete factors. Rather, in agreement with several other courts of appeals that have addressed the issue, the court rejected the proposition that the bad-faith-intent-to-profit factors can simply be counted as if they were beads on an abacus. Pet. App. 21a. The court properly recognized that the factors should be considered in light of the known statutory objective of the ACPA – to provide a remedy against "cybersquatters" who registered domain names that embodied trademarks for the purpose of extorting a payment from the trademark holder or otherwise deriving a financial profit from

the goodwill that belonged to another. Where a domain name is registered for use for a non-commercial gripe site about the trademark holder, with no extortionate intent, the courts of appeals have consistently found no bad faith intent to profit. Pet. App. 24a-26a (citing cases). Falwell does not identify any circuits whose holdings conflict with this basic holding below, and he never presented such an argument to the court of appeals.

The fragment of the opinion below with which Falwell's Question Presented takes issue was incidental to the holding that Lamparello did not have a bad faith intent to profit, and the petition does not take issue with this consensus position of the courts of appeals. Accordingly, there is no reason to grant review to determine whether this aspect of the opinion correctly analyzes Factor IV.[5]

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

Paul Alan Levy

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[5]The body of the Petition, at 28-29, also makes an argument about the ACPA's safe harbor provision, 15 U.S.C. § 1125(d)(1)(B)(ii), although the issue is not mentioned in the Question Presented. Although Lamparello relied on that provision below, the court of appeals did not address it, and neither did Falwell, even in his rehearing petition. The issue is therefore neither presented nor preserved for review.

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No. 05-980

IN THE

Supreme Court of the United States

JERRY FALWELL and JERRY FALWELL MINISTRIES,

Petitioners,

v.

CHRISTOPHER LAMPARELLO,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOURTH CIRCUIT

REPLY BRIEF

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INTRODUCTION

The decision of the Fourth Circuit should not be allowed to stand because it incorrectly rejects the doctrine of initial interest confusion in trademark law and holds that even were it applied, it would not be invoked in a noncommercial context, thus eviscerating the efficacy of trademark protection wherever the (otherwise) infringer forswears "[p]rofiting financially." *Lamparello v. Falwell,* 420 F.3d 309, 317 (4th Cir. 2005), Pet. App. 1a, 15a.

Petitioners, Jerry Falwell and Jerry Falwell Ministries (collectively, "Falwell") concur with Respondent, Christopher Lamparello, that it is incumbent upon this Court to "decide[e] whether, and to what extent, the doctrine [of initial interest confusion] should be made a permanent part of trademark law." Brief in Opposition at 9. We disagree that this is not the case in which to do it.

There are two factual errors in Lamparello's Brief in Opposition. *First,* that "there was no evidence of actual initial interest confusion." Brief in Opposition at 8. As the District Court found, "The Counter-claimants [Falwell] have also shown actual confusion. Counter-claimants have presented evidence that individuals have specifically confused the Counter-Defendant's website with a website run by the Counter-Claimants." App. 32a. This case is not about and has never been about what Internet users do after they have gotten to the Lamparello fallwell.com site and figured out it is not that of Petitioners. This case is about their being duped in the first place by the infringing use of Dr. Falwell's trademark as Respondent's confusingly similar domain name. App. 32a. *Second*, that "there was no evidence even suggesting that Falwell was losing visitors to this website because of Lamparello's [fallwell.com] website." Brief in Opposition at 8. Quite to the contrary:

> [The] webmaster at falwell.com, ran a search of the server logs from May 1 – May 22, 2004. Recall, too, that Lamparello has a link to falwell.com on

> his web site. Thus, those looking for Dr. Falwell can get there after they have been subjected to the pro-gay propaganda on fallwell.com. Mr. Peterson reports that *www.fallwell.com* referred 231 unique hits to *www.falwell.com* during the 3-week period and *www.jerryfallwell.com* referred 339 unique hits to *www.falwell.com*. Second Peterson Affidavit. Reply Brief For Defendants/ Counterclaimants Jerry Falwell And Jerry Falwell Ministries In Support Of Motion For Summary Judgment, filed June 4, 2004 at 23.

The stipulation quoted by Lamparello[1] that there was "no measurable impact on the quantity of visits to defendants' [Falwell's] web site" must be taken to mean no more than exactly what it says—that the impact was not measurable. Which is precisely what the evidence was:

> It is true Counterclaimants [Falwell] have no way of measuring the impact of fallwell.com on their web site, Supplemental Stipulation, but that does not mean there is none. We have no idea how many internet users seeking Dr. Falwell's site go mistakenly to Lamparello's site and go no further. *Id.* at 24.[2]

Lamparello mistakenly would have that stipulation read as if it said there was zero impact or that the impact was de minimis.

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1. Brief in Opposition at 8.

2. *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Center*, 109 F.3d 275, 284 (6th Cir.; 1997) (noting that absence of actual confusion is generally of little weight because of the difficulty in obtaining such evidence.)

REASONS FOR GRANTING THE PETITION

I. That The Fourth Circuit's *Lamparello* Decision Marks Two Splits With Its Sister Circuits Is All The More Reason To Grant Certiorari.

The Fourth Circuit's bottom line, that the "record evidences no likelihood of confusion," Pet. App. 12a, was reached and only could be reached by examining the content of the respective websites. *Id.* at 11a-12a. To do that, it was necessary to reject the doctrine of initial interest confusion, which it did—Pet. App. 13a—while not even pausing for breath to graft a commercial, or financial profit motive, element onto it. No doubt the foregoing combination constitutes a case of first impression. But each part stands on its own and constitutes precedent as to each, obligatory in all of the states that make up the Fourth Circuit. The Petition amply demonstrates that the circuit split as to the initial interest confusion doctrine has six circuits lined up on one side and the Fourth Circuit on the other. Similarly, the split as to whether the Lanham Act is content neutral as between infringing commercial or noncommercial speech, except where congressionally provided for otherwise, has the Second and Ninth Circuits on one side and the Fourth on the other.

Lamparello is unable to distinguish or dispel any "one of the dozens of cases cited in the petition. . . ." Brief in Opposition at 8. Instead Lamparello disparages those who misspell Dr. Falwell's last name as being "careless or inattentive." Brief in Opposition at 7. But Judge Learned Hand disposed of that argument nearly eighty years ago:

> It is, however, generally held that *mere misspelling is not enough* [to avoid confusion]. Whether this is because the public is not assumed to be critical enough to detect the contrivance, or whether the mark could have no scope, the books do not say. *The difficulty is double; a reader who knew how to spell might be in doubt whether the mistake was deliberate; one who did not, would be unaware that*

> *it was a mistake at all.* We need not say that the perversion might not be so obvious as to stamp upon the mark its artificial origin and show its purpose, for in such matters it is especially unsafe to be absolute. It does seem to us, however, that *the misspelling of a single letter is too little*, for, while to many it might be enough, over many it would pass unnoticed. *Oakland Chemical Co. v. Bookman*, 22 F.2d 930, 931 (2d Cir. 1927) (internal citations omitted and emphases added).

Are those who mistakenly spell Wal*Mart as Wall*Mart or Sears Roebuck as Sears Rowbuck "careless or inattentive"? Most assuredly not. They are simply unknowledgeable as to the correct spelling. So too, with Fallwell and fallwell.com. In any event, that argument, going to the merits, hardly detracts from why certiorari should be granted.

Unquestionably it is highly unusual for any one court of appeals decision to create two circuit splits. That this one does, makes it all the more imperative that the petition for certiorari be granted.

II. The Reach Of The Anticybersquating Consumer Protection Act Is An Important Question Of Federal Law That Should Be Clarified.

Lamparello at no point addresses the merits of Falwell's argument that the Anticybersquatting Consumer Protection Act (ACPA) never before having been addressed by this Court should have its reach clarified. Instead, he asserts that Falwell has not preserved this argument for review. It rings loudly that Lamparello cites no case in support of his argument.

Nor does Falwell understand the argument. Falwell prevailed in the District Court and was well satisfied with its disposition of the ACPA count.[3] It was not until the opinion

3. Other than the District Court's failure to award statutory damages and attorneys' fees, which were the basis for Falwell's cross-appeal.

under review issued that Falwell had any disagreement with how the ACPA matter had been decided. No petition for rehearing or rehearing en banc was necessary to the court of appeals' disposition of the ACPA question in order to make it ripe for review in this Court. *See* Supreme Court Rule 13(3), which merely provides that if a petition for rehearing is timely, the time for filing a petition for certiorari runs from the time of denial of rehearing. The purposes and page limitations on petitions for rehearing and petitions for certiorari are wholly different.

It is irrelevant that there is no split in the circuits as to Question 2—the reach of ACPA. It is "an important question of federal law that has not been, but should be, settled by this Court." Sup. Ct. R. 10(c).

CONCLUSION

The Court should grant this petition and bring the Fourth Circuit into line with its sister circuits accepting the viability of the initial interest confusion doctrine in trademark law as well as cure the Circuit of the notion that it may rewrite the Lanham Act to divine a noncommercial exemption not authored by Congress. So too, the reach of the Anticybersquatting Consumer Protection Act is an important question of federal law that has never before reached this Court.

Respectfully submitted,

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